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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/483,766	01/19/2000	Veronique Mahe	ROC-17	8806

7590 02/14/2006
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EXAMINER

FUBARA, BLESSING M

ART UNIT PAPER NUMBER

1618

DATE MAILED: 02/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/483,766	Applicant(s) MAHE ET AL.	
	Examiner Blessing M. Fubara	Art Unit 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Examiner acknowledges receipt of after final amendment and remarks filed 1/11/06.

Claims 35-37 are pending.

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 102

2. The rejection of claims 1-13, 15-17 and 19 under 35 U.S.C. 102(b) as being anticipated by Fowler et al. (US 5,534,265) is withdrawn in view of the cancellation of the said claims.
3. The rejection of claims 1-3, 15-17 and 21-23 under 35 U.S.C. 102(a) as being anticipated by Koga (JP 10, 231,238) is withdrawn in view of the cancellation of the claims.

Claim Rejections - 35 USC § 103

4. The rejection of claims 14 and 20 including claims 35-37 under 35 U.S.C. 103(a) as being unpatentable over Fowler et al. (US 5,534,265) is withdrawn in view of the cancellation of claims 14 and 20 and the amendment of claims 35-37 where the composition that is applied to the skin consists essentially of ... in claim 35.

Allowable Subject Matter

5. Claims 35-37 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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It was also noted that since the composition of Koga is a cosmetic, applying the composition to the skin would inherent cleanse and freshen the skin; shower gels and foaming gel are forms of cosmetic composition.

Therefore, the objection of those claims as being dependent on a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims is withdrawn.

The rejection below which is made over the art of record follows.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Koga (JP 10, 231,238).

Koga in JP 10,231,238 teaches a cosmetic composition that is prepared by adding 0.001-10.0 weight percent of menthol and at least one of menthyl lactate, menthyl glycoside menthyl hydroxybutyrate, menthoxypropanediol and menthoxyfurane (abstract). In the instant claims the ratio of menthol to menthyl lactate is in the range of from about 1/3 to about 1/10 and the amounts of menthol at from about 0.01% to about 2% by weight and menthyl lactate from about 0.1% to about 10% in the composition would satisfy the ratio. In the prior art, because amounts of menthol and menthyl lactate lie within and overlap the recited range, a certain composition of the prior art would have the recited ratio of menthol to menthyl lactate. Specifically, Koga's Examples 1, 4, 10 and 16 are compositions containing menthol and menthyl lactate, glycerol, ethanol and isopropyl alcohol and the ratio of the menthol to methyl is 1:1 for Example 4, 2:1 for

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Example 1 and 3:1 for Examples 10 and 16 (see pages 4 and 5 of the translation). Paragraph [0005] of the translation talks about “refreshing feeling.” Paragraph [0011] of the translation discloses applying the cosmetic composition to the face.

Koga discloses a composition containing menthol and menthyl lactate. Glycerol and ethanol are carriers. The claimed method uses the menthol formulation as a shower gel and as a foaming gel for the face. A shower gel or foaming facial gel must contain at least a gelling agent and the applicants’ shower gel contains surfactant, hydroxypropyl methylcellulose, preservative and fragrances in addition to the menthol and menthyl lactate. Koga does not state that the cosmetic is used as a shower gel. However, shower gel or facial gel is form of cosmetics. Regarding the menthol/methyl ratio of 1:3 to about 1:10, it is noted that there is no demonstration that the recited menthol/menthyl ratio provides unexpected results.

The transitional phrase “consisting essentially of” limits the scope of a claim to the specified materials or steps “and those that do not materially affect the basic and novel characteristic(s)” of the claimed invention. In re Herz, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). In the instant case, the composition Koga ha the same basic and novel characteristic of cleansing and freshening the skin.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare and apply the composition of Koga to the face or skin. One having ordinary skill in the art would have been motivated to use the composition of Koga in shower gel with the expectation that the shower gel will provide similar/same sustained refreshing feel as when applied to the face.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Blessing Fubara
Patent Examiner
Tech. Center 1600

A handwritten signature in black ink, appearing to read "MB Fubara", is written over the printed name "Blessing Fubara".